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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/505,455

03/21/2005

Shinichi Kai

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1786

22850

7590

01/12/2009

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

01/12/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/505,455	<b>Applicant(s)</b> KAI ET AL.	
	<b>Examiner</b> Mathieu D. Vargot	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/6 &amp; 11/14/08</u> .                                     | 6) <input type="checkbox"/> Other: _____                          |

1. Claims 3, 4, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As claims 1 and 5 have been amended, it is not clear whether claims 3, 4, 7 and 8 actually further limit the independent claim. For instance, the independent claims now recite that the evaluation laser light is irradiated on the non-recording area of the resist layer and the dependent claims in question appear to set forth no more than this.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Kokai 60-254,432.

Japanese -432 discloses the basic claimed method of making either a disk or master disk by irradiating a film of inorganic material with a "special property" using a test laser (ie, the He/Ne laser) and using the results of this test to control the recording Ar laser. Essentially, the applied reference lacks a clear teaching that the test sites are "non-recording areas" and that the disk made is a master disk. Since the sites tested are different than those recorded, it is not even clear that the tested sites are not in "non-recording" areas. However, it is also rather clear that it makes no difference in the method of the applied reference and hence would also not make any difference in the instant method. To wit, if the areas being tested are in fact "recording" areas, then it

Art Unit: 1791

doesn't make any difference if they are first tested and then later recorded, because that is what the applied reference would be teaching. If the testing is occurring in "non-recording" areas, then it meets that portion of the independent claims calling for such. Either way, this aspect is either taught in Japanese -432 or obvious thereover. It is also not clear exactly what kind of disk is being made in the applied reference—either a master to be used in making a stamper for individual disks or an individual disk itself. However, either method is well known in the art and would have been obviously employed by one of ordinary skill in the art to make individual disks as desired. It is submitted that Japanese -432 discloses the exposing and developing to form the patterns and that the light modulator (5 in the Figure) controls the light intensity of the Ar recording laser based on the test results. It would have been obvious to employ an exposure focusing position adjustment in lieu of a light intensity adjustment as such would accomplish the same result in performing the recording.

3. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Kokai 60-254,432 in view of either of Chaiken et al (see coil. 2, lines 8-34) or Japanese document 2003-315,988(see abstract).

Japanese Kokai -432 is applied for reasons of record as set forth in paragraph 2, supra, the primary reference failing to disclose the instant inorganic resist layer containing incomplete oxides of transition metals. Either secondary reference discloses that these are well known in the art and they would have been obviously employed as the "special property" inorganic resists of the primary reference to facilitate the recording process.

4.Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

Upon reconsideration, it is believed that the claims are properly rejected over the art as applied. The 112 aspects also need to be addressed. Applicant is requested to provide a translation of Japanese 60-254,432, as the reference is particularly pertinent to the instant claims.

5.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot  
January 2, 2009

/Mathieu D. Vargot/  
Primary Examiner, Art Unit 1791